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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY/DOCKET NO.
09/149,747	02/06/78	CLARK, ROBERT	A

QM11/1125

HAN, P EXAMINER

ART-UNIT

PAPER NUMBER

11/25/98  
*3*

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/149,747</b>	Applicant(s) <b>GLUCK</b>
	Examiner <b>Frances Han</b>	Group Art Unit <b>3722</b>

Responsive to communication(s) filed on Sep 8, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 6-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 6-20 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The preliminary amendment filed on September 8, 1998 has been received and entered.

***Drawings***

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2D 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 6-20 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 5,803,501 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an article of memorabilia comprising: a first member and a portion, but not the entirety, of an authentic memorabilia item used by a popular sport or entertainment personality or during a memorable event, said portion attached to said first member.

Furthermore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 U.S.C. § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The phrase "the said" in claim 7, line 2 is awkwardly written.

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***Claim Rejections - 35 U.S.C. § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 6, 7, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by the German patent DE 4344933.

The German patent discloses an article of memorabilia including a first member 1 having a portion 7 of an authentic memorabilia item used during a memorable event incorporated into or attached to the first member.

***Claim Rejections - 35 U.S.C. § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 8-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the German patent, as used above.

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The German patent discloses the claimed memorabilia article except for the specific type of authentic item, such as a sports ball or item of clothing, being attached to the first member or the specific type of first member to be a trading card. The German patent teaches that any type of sample, model or similar object 7 may be attached to the first member. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the authentic item of the German patent to include a sports ball or item of clothing to be attached to the card since the German patent teaches that any type of sample, model or similar object may be attached to the first member. Furthermore, the exact type of first member to be a sports trading card having an image surface would have been an obvious matter of design choice since the German patent teaches a postcard (a type of trading card) having an image thereon and the specific use of the trading card as a sports trading card would have been an intended use.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. Transmissions can be received from the Applicant at all times.

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This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. The faxing of such documents must conform with the notice published in the Official Gazette, 1096 OG 30 (October 19, 1988). Please identify the Examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the Examiner. Applicant is reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Frances Han whose telephone number is (703) 308-0183. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, A. L. Pitts, can be reached on (703) 308-2159.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

  
FRANCES HAN  
PRIMARY EXAMINER  
ART UNIT 3722

FCH

November 20, 1998